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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SYDNEY KEITH SEYMOUR, BALAGER ADEME,
CALVIN WAYNE HENDERSON, and JOHN LARKIN NELSON

Appeal 2009-009564
Application 10/725,355
Technology Center 1700

Before PETER F. KRATZ, LINDA M. GAUDETTE, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-3, 5-12, 14-19, 22-29 and 31. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Claim 1 is illustrative of Appellants' invention:

1. An apparatus adapted to examine a length of a cigarette paper comprising a pattern including a first band and a second band, the pattern repeating along the length thereof, the apparatus comprising:

a second bobbin configured to be capable of receiving the cigarette paper and to have the cigarette paper advanced thereto and wound thereon after the cigarette paper is unwound from a first bobbin;

a pattern detection device disposed between the first and second bobbins and configured to receive the cigarette paper unwound from the first bobbin, the pattern detection device being configured to detect at least one of the bands and produce a signal in response thereto; and

a testing device in communication with the pattern detection device and disposed serially therewith between the first and second bobbins, the testing device being configured to nondestructively measure at least one of a porosity and a basis weight of at least one of the bands in contemporaneous response to the signal, while the cigarette paper is between the first and second bobbins and before the cigarette paper is wound on the second bobbin.

The Examiner maintains, and Appellants appeal, the following rejections under 35 U.S.C. § 103(a):

1) claims 1-3, 5, 6, 8-12, 14, 15, 17-19, 22, 23, 25-29 and 31 as unpatentable over the combined prior art of Bokelman², Cholet³, and

² US Patent 5,966,218, issued Oct. 12, 1999.

Seymour⁴;

2) claims 7, 16, and 24 as unpatentable over the combined prior art of Bokelman, Cholet, Seymour, and George⁵;

Appellants argue the claims rejected in the first rejection only as a group (App. Br. 5-13). Thus, we select independent claim 1 as the representative claim on which our discussion will focus.

Appellants rely upon the arguments present for the first rejection, and do not present any additional arguments specific to the second ground of rejection (App. Br. 13).

MAIN ISSUE ON APPEAL

Did the Examiner err in determining that the claimed cigarette paper band detection and testing apparatus would have been obvious over the combined prior art, because, as alleged by Appellants, the stated motivation of saving time and money “does not provide, in this instance, an objective reason to combine the teachings of the references” (Reply. Br. 3; emphasis in original)?

We answer this question in the negative.

PRINCIPLES OF LAW

In assessing whether a claim to a combination of prior art elements would have been obvious, the question to be asked is whether the improvement of the claim is more than the predictable use of prior art elements according to their established functions. *KSR Int'l. Co. v. Teleflex*

³ Cholet WO 03/0191321 A1, published Mar. 3, 2003 (It is undisputed that US Patent Publication 2004/0187560 may be relied upon as the English translation (App. Br. 5)).

⁴ US 2004/0122547 A1, published Jun. 24, 2004

⁵ US Patent 3,032,245 issued May 1, 1962.

Inc., 550 U.S. 398, 417 (2007). The analysis need not seek out precise teachings directed to the specific subject matter of the claim, for it is proper to take account of the inferences and creative steps that a person of ordinary skill in the art would employ. *Id.* at 418.

“[O]ne cannot show non-obviousness by attacking references individually where ... the rejections are based on combinations of references.” *In re Keller*, 642 F.2d 413, 426 (CCPA 1981).

ANALYSIS

with Factual Findings

We adopt the factual findings and reasoning of the Examiner (Ans. 3-11; Final Office Action pp. 2-9) and add the following primarily for emphasis.

Appellants’ contentions in the briefs amount to an allegation that there is insufficient motivation to combine the teachings of the applied prior art to result in a porosity tester of Cholet located downstream of the band detection device of Bokelman, and to have used a signal from the band detection device to contemporaneously determine when to use the porosity tester (*generally* App. Br; Reply Br.). Specifically, Appellants argue that the Examiner’s stated motivation of saving time and money is too “broad” (*see e.g.*, App. Br. 9), the Examiner used impermissible hindsight (App. Br. 11), and Cholet teaches away from the claimed combination (App. Br. 12). These arguments are of no persuasive merit.

First, Bokelman explicitly states “[a]s the paper passes from the unwind bobbin to the rewind bobbin, *one or more* inspection stations *analyze the properties of the paper.*” (Bokelman, col. 2, ll. 38-40 (emphasis added); *see also* Ans. 4, 10.)

Second, Cholet exemplifies that porosity testing of cigarette paper in the region of the detected bands is desirable (*see, e.g.*, Ans. 5, 10). Thus, the motivation provided by the Examiner includes that it would have been obvious to use a known testing device in order to determine a property of the paper which was known to have been desirable information (Ans. 6, 10). We also agree with the Examiner that since each of Bokelman, Cholet, and Seymour exemplify the importance of measuring the position of the bands in banded paper, and Seymour also exemplifies that sending a signal from a band detection device to control other devices was within the skill in the art, that sending a signal from the band detection device of Bokelman to contemporaneously determine when to use the added porosity tester would have also been within the ordinary level of skill in the art (Ans. 10-11).

It is well established that the prior art as a whole must be considered. Appellants' arguments in large part improperly focus on the teachings of the references individually instead of addressing the Examiner's stated case. *Keller*, 642 F.2d at 426.

Appellants' argument that Cholet teaches away because Cholet states that the only way to detect strip/band positioning is continuous porosity testing is unavailing (App. Br. 13), since, as the Examiner points out, Bokelman teaches an alternative way to determine the band positions (*see e.g.*, Ans. 10-11).

Notably, Appellants do not dispute the Examiner's finding that the proposed combination would have saved time and money (App. Br; Reply Br. *generally*).⁶

⁶ *See also Dystar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1368 (Fed. Cir. 2006) ("[A]n implicit

Furthermore, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR* at 421. The Examiner’s position is reasonable in view of the applied prior art, and Appellants have not provided any convincing technical reasoning nor evidence that one of ordinary skill in the art would not have, using no more than ordinary creativity, successfully combined a known porosity tester such as exemplified by Cholet into the bobbin optical inspection system of Bokelman, and would have used a control signal from the band detection device of Bockelman to determine when to use the porosity tester (*generally* App. Br.; Reply Br.).

Thus, the addition of a porosity tester as one of the “inspection stations [to] analyze the properties of the paper” (Bokelman col. 2, ll. 38-40) would have been nothing more than using a known technique in accordance with its known function for the predictable result of analyzing the porosity property of the paper. *See KSR*, 550 U.S. at 416 (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal—and even common-sensical—we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references.”).

Accordingly, the evidence as a whole supports the Examiner's conclusion of obviousness, and on the record before us, we sustain the § 103 rejections of claims 1-3, 5-12, 14-19, 22-29 and 31 as maintained by the Examiner.⁷

DECISION

We affirm the Examiner's § 103 rejections.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

tc

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⁷ Only those arguments actually made by Appellants have been considered in this decision. Arguments which could have made but Appellants chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).